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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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G ROGER LEE  
FISH & RICHARDSON  
225 FRANKLIN STREET  
BOSTON MA 02110-2804

EXAMINER
RUNES, C

ART UNIT	PAPER NUMBER
2171	82

DATE MAILED: 08/24/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.

09/240,563

Applicant(s)

BOOTHBY, DAVID J.

Examiner

Charles L. Rones

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

## Status

- 1) ☐ Responsive to communication(s) filed on 05 July 2001.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 22-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 22-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some \* c) ☐ None of the CERTIFIED copies of the priority documents have been:
1. ☐ received.
2. ☐ received in Application No. (Series Code / Serial Number) \_\_\_\_\_.
3. ☐ received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).

## Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

## DETAILED ACTION

### *Response*

1. The response timely filed on July 5, 2001 has been entered.

### *Double Patenting*

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 22-27 are rejected under the judicially created doctrine of double patenting over claims 1, 6-7, 9, 17-19, & 21-22 of U. S. Patent No. 5,684,990 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent. The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: Although, the conflicting claims are not identical, they are not patentably distinct from each other because the claims are slightly narrower than claim 1, 6-7, 9, 17-19, & 21-22 of Boothby et al. '990, which encompasses the same metes, bounds, and limitations. Therefore, it would be obvious to add slight limitations of to the broader claims, since it has been held that omission of an element

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and its function and a combination where the remaining elements perform the same functions as before involves only routine skill in the art. See *In re Karlson*, 136 USPQ 184.

### ***Response to Arguments***

4. Applicant's arguments filed July 5, 2001 have been fully considered but they are not persuasive. Applicant states the following:

Any patent issuing on this application would necessarily, under the statute, expire on January 11, 2015, twenty years from the filing date of the earliest filed application from which priority was claimed. That is the same day on which U.S. Patent No. 5,684,990 will expire. Accordingly, it is unnecessary and inappropriate to require a terminal disclaimer.

Applicant further states "The PTO had authority from judicial decisions to require the disclaimer of term, but it had no authority to require common ownership."

The examiner agrees with applicant's argument concerning the expiration term of U.S. Patent No. 5,684,990 and this current patent application. However, the examiner disagrees with applicant's statement that it is "unnecessary and inappropriate to require a terminal disclaimer." Filing a terminal disclaimer would have the effect of keeping the current patent and the application, assuming the application in fact issues as a patent, together should one be sold in the future. As happened in the case of *In re Ornum*,<sup>1</sup> which is cited in the first "Double Patenting" office action. Office policy requires that a "Double Patenting" rejection should issue in cases where broader claims of one patent read on the narrower claims of another patent. Furthermore, Examiner disagrees that

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<sup>1</sup> *In re Van Ornum*, 686 F.2d 937, 944-48, 214 USPQ 761, 767-70 (CCPA 1982).

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there is no judicial decision requiring common ownership in a situation such as here.

The MPEP requires a terminal disclaimer to be filed under the circumstance here as dictated by judicial decisions even under the situation of a 20 year patent term.

Section 804.02 III-IV of the MPEP<sup>2</sup> dictates "office policy" by stating the requirements of a "Terminal Disclaimer" for a "Double Patenting" rejection, which cites

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<sup>2</sup> MPEP Section 804.02

III. REQUIREMENTS OF A TERMINAL DISCLAIMER

A terminal disclaimer is a statement filed by an owner (in whole or in part) of a patent or a patent to be granted that is used to disclaim or dedicate a portion of the entire term of all the claims of a patent. The requirements for a terminal disclaimer are set forth in 37 CFR 1.321. Sample forms of a terminal disclaimer are provided in MPEP § 1490.

IV. TERMINAL DISCLAIMERS REQUIRED TO OVERCOME  
JUDICIALLY CREATED DOUBLE PATENTING REJECTIONS IN  
APPLICATIONS FILED ON OR AFTER JUNE 8, 1995

Public Law 103-465 (1994) amended 35 U.S.C. 154(a)(2) to provide that any patent issuing on a utility or plant application filed on or after June 8, 1995 will expire 20 years from its filing date, or, if the application claims the benefit of an earlier filed application under 35 U.S.C. 120, 121, or 365(c), 20 years from the earliest filing date for which a benefit under 35 U.S.C. 120, 121, or 365(c) is claimed. Therefore, any patent issuing on a continuing utility or plant application filed on or after June 8, 1995 will expire 20 years from the earliest filing date for which a benefit is claimed under 35 U.S.C. 120, 121, or 365(c), subject to the provisions of 35 U.S.C. 154(b).

There are at least two reasons for insisting upon a terminal disclaimer to overcome a judicially created double patenting rejection in a continuing application subject to a 20-year term under 35 U.S.C. 154(a)(2). First, 35 U.S.C. 154(b) includes provisions for patent term extension based upon prosecution delays during the application process. Thus, 35 U.S.C. 154 does not ensure that any patent issuing on a continuing utility or plant application filed on or after June 8, 1995 will necessarily expire 20 years from the earliest filing date for which a benefit is claimed under 35 U.S.C. 120, 121, or 365(c). Second, **37 CFR 1.321(c)(3) requires that a terminal disclaimer filed to obviate a double patenting rejection include a provision that any patent granted on that application be enforceable only for and during the period that the patent is commonly owned with the application or patent which formed the basis for the rejection. This requirement serves to avoid the potential for harassment of an accused infringer by multiple parties with patents covering the same patentable invention (37 CFR 1.601(n)). See, e.g., In re Van Ornum, 686 F.2d 937, 944-48, 214 USPQ 761, 767-70 (CCPA 1982). **Not insisting upon a terminal disclaimer to overcome a judicially created double patenting rejection in an application subject to a 20-year term under 35 U.S.C. 154(a)(2) would result in the potential for the problem that 37 CFR 1.321(c)(3) was promulgated to avoid.****

Accordingly, a terminal disclaimer under 37 CFR 1.321 is required in an application to overcome a judicially created double patenting rejection, even if the application was filed on or after June 8, 1995 and claims the benefit under 35 U.S.C. 120, 121, or 365(c) of the filing date of the patent or application which forms the basis for the rejection. Examiners should respond to arguments that a terminal disclaimer under 37 CFR 1.321 should not be required in a continuing application filed on or after June 8, 1995 to

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the Federal Circuit (formerly United States Court of Customs and Patent Appeals) case named *In re Van Ornum*.<sup>3</sup>

The Appellant's of *In re Van Ornum*, challenged regulation 37 CFR 1.321(b), wherein a terminal disclaimer is required to overcome a "Double Patenting" rejection. Appellant's argued that the regulation was invalid as there was no court decision, which allowed the Patent Office to impose such a requirement. The court in *In re Van Ornum*, found the regulation to be valid and that common ownership is required under the regulation. *In re Van Ornum* is now the court decision, which makes 37 CFR 1.321 valid. The court stated that there was no substantial obstacle to tie both termination and ownership of the two patents together. In shephardizing, *In re Van Ornum*, there are no negative treatments in any of the 15 cited decisions. This year (2001), the Federal Circuit cited *In re Van Ornum* in the *Eli Lilly*<sup>4</sup> case without any negative treatment. Therefore, under the MPEP and judicial authority, the Examiner's "Double Patenting" rejection requiring a terminal disclaimer is deemed legal valid and appropriate.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not

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overcome a judicially created double patenting rejection due to the change to 35 U.S.C. 154 by citing to this section of the MPEP or to the Official Gazette notice at 1202 O.G. 112 (Sept. 30, 1997).

<sup>3</sup> *In re Van Ornum*, 686 F.2d 937, 944-48, 214 USPQ 761, 767-70 (CCPA 1982).

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mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles L. Rones whose telephone number is 703-306-3030. The examiner can normally be reached on Monday-Thursday 8am-4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas G. Black can be reached on 703-305-9707. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-9051 for regular communications and 703-308-9051 for After Final communications.

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<sup>4</sup> *Eli Lilly and Co. v. Barr Labs.*, 251 F.3d 955, 2001 U.S. App. LEXIS 11241, 58 U.S.P.Q.2d (BNA) 1869 (Fed. Cir. 2001).

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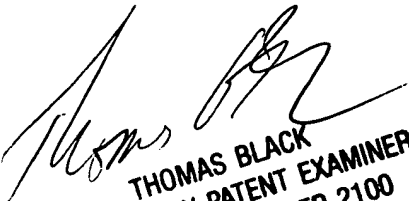
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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3800.

A handwritten signature in black ink, appearing to be 'CLR'.

July 25, 2001

A handwritten signature in black ink, appearing to be 'Thomas Black'.

THOMAS BLACK  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100